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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,733

03/23/2005

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EXAMINER

GREEN, ANTHONY J

ART UNIT

PAPER NUMBER

1755

MAIL DATE

DELIVERY MODE

08/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

10/528,733

### Applicant(s)

UEDA ET AL.

### Examiner

Anthony J. Green

### Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-9,11,13,15,17 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-9,11,13,15,17 and 19-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/15/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment submitted on 28 June 2007. After entry of the amendment claims 1-2, 6-9, 11, 13, 15, 17 and 19-29 are currently pending.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 25-26 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 04-293982A for the reasons set forth in the previous office action and which are herein incorporated by reference:

Applicant argues that the instant claims are not met by the reference as the limitations of claims 3 and 4 have been inserted into claim 1 and therefore the reference does not teach the currently claimed composition.

To this position the examiner respectfully disagrees as the reference teaches amounts of components that encompass those instantly claimed. As for the limitation of "at most 50 parts by weight of a matting agent" this limitation includes "0" as a lower limit and therefore it need not be present in the composition. Accordingly the instant claims are met by the reference.

4. Claims 1, 25-26 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 02-158675A for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference as the limitations of claims 3 and 4 have been inserted into claim 1 and therefore the reference does not teach the currently claimed composition.

To this position the examiner respectfully disagrees as the reference teaches amounts of components that encompass those instantly claimed. As for the limitation of "at most 50 parts by weight of a matting agent" this limitation includes "0" as a lower limit and therefore it need not be present in the composition. Accordingly the instant claims are met by the reference.

5. Claims 1, 25-26 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 04-31474A for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference as the limitations of claims 3 and 4 have been inserted into claim 1 and therefore the reference does not teach the currently claimed composition.

To this position the examiner respectfully disagrees as the reference teaches amounts of components that encompass those instantly claimed. As for the limitation of "at most 50 parts by weight of a matting agent" this limitation includes "0" as a lower

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limit and therefore it need not be present in the composition. Accordingly the instant claims are met by the reference.

6. Claims 1, 25 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 04-285680A for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference as the limitations of claims 3 and 4 have been inserted into claim 1 and therefore the reference does not teach the currently claimed composition.

To this position the examiner respectfully disagrees as the reference teaches amounts of components that encompass those instantly claimed. As for the limitation of "at most 50 parts by weight of a matting agent" this limitation includes "0" as a lower limit and therefore it need not be present in the composition. Accordingly the instant claims are met by the reference.

7. Claims 1, 25-26 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 02-158672A for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference as the limitations of claims 3 and 4 have been inserted into claim 1 and therefore the reference does not teach the currently claimed composition.

To this position the examiner respectfully disagrees as the reference teaches amounts of components that encompass those instantly claimed. As for the limitation of "at most 50 parts by weight of a matting agent" this limitation includes "0" as a lower limit and therefore it need not be present in the composition. Accordingly the instant claims are met by the reference.

8. Claims 1, 25-26 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Mabuchi et al (US Patent No. 4,572,871) for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference as the limitations of claims 3 and 4 have been inserted into claim 1 and therefore the reference does not teach the currently claimed composition.

To this position the examiner respectfully disagrees as the reference teaches amounts of components that encompass those instantly claimed. As for the limitation of "at most 50 parts by weight of a matting agent" this limitation includes "0" as a lower limit and therefore it need not be present in the composition. Accordingly the instant claims are met by the reference.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 19 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. 04-293982A, Japanese Patent Specification No. 02-158675A, Japanese Patent Specification No. 04-31474A, Japanese Patent Specification No. 04-285680A, Japanese Patent Specification No. 02-158672A, and Mabuchi et al (US Patent No. 4,572,871).

The references were discussed previously.

The instant claims are obvious over the references. While the references do not recite the same types of fluorine resin, they do broadly teach the use of a fluorine containing resin and therefore in the absence of evidence showing otherwise, it would have been obvious to utilize any fluorine containing resin without producing any unexpected results as the basic premise of the use of a fluorine containing resin is taught by the reference.

### ***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1-2, 6-9, 11, 13, 15, 17 and 19-29 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of particular fluorine containing resins and silicone oils, does not reasonably provide enablement for the use of any and all fluorine containing resins and silicone oils known to man. The

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specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The claims recite a paint composition for leather comprising a fluorine-containing resin and a silicone oil. This encompasses any fluorine-containing resin and silicone oil. However, the specification only teaches the use of certain types. Such a limited disclosure does not support the breadth of the instant claims.

Applicant has not provided any arguments as to why the rejection pertaining to the types of materials and accordingly it is repeated.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



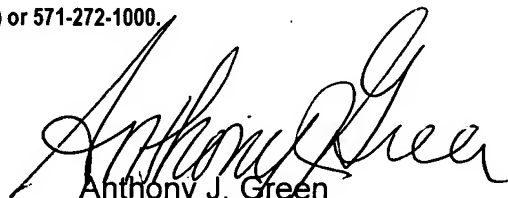
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg

August 8, 2007